UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,

Petitioner,

v.

NOKIA TECHNOLOGIES OY,

Patent Owner.

IPR2025-01338
U.S. Patent No. 7,724,818

PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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EXHIBIT LIST

Exhibit	Reference	New
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1002	Certified File History of the '818 Patent ("'818FH")	
1003	Declaration of Dr. Eli Saber ("Saber")	
1004	Curriculum Vitae of Dr. Eli Saber	
1005	Intentionally Left Blank	
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1008	U.S. Patent No. 6,646,578 ("Au")	
1009	Intentionally Left Blank	
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1012	H.26L over IP and H.324 Framework ("VCEG-N52"), available at https://www.itu.int/wftp3/av-arch/videosite/0109_San/VCEG-N52.doc	
1013	Analysis of fractional pixel interpolation for MC prediction ("VCEG-N55"), available at https://www.itu.int/wftp3/avarch/video-site/0109_San/VCEG-N55.doc	
1014	Declaration of Sylvia Hall-Ellis ("Hall-Ellis")	
1015	A. Murat Tekalp, DIGITAL VIDEO PROCESSING (Prentice Hall pub., 1st ed. 1995) ("Tekalp")	
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1025	Memorandum from Coke Morgan Stewart on Interim Processes for PTAB Workload Management (Mar. 26, 2025) ("Acting Director Memo")	**X**
1026	USPTO, FAQs for Interim Processes for PTAB Workload Management, https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management (last visited Sept. 18, 2025)	**X**
1027	Interim Director Discretionary Process, USPTO, https://www.uspto.gov/patents/ptab/interim-director-discretionary-process (last visited Oct. 31, 2025)	**X**
1028	Notice of Dismissal, *Element Television Co., LLC v. Nokia Corporation et al.*, Case No. 24-cv-4269 (LMB/DTS) (D. Minn. Aug. 18, 2025)	**X**
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1030	Memorandum from John A. Squires on Director Institution of AIA Trial Proceedings (Oct. 17, 2025) ("Director Institution Memo")	**X**
2004	Declaration of Dr. Eli Saber, Ph.D. Regarding U.S. Patent No. 7,724,818 in IPR2024-00572	
2009	Complaint for Declaratory Judgment in *Element Television Co., LLC v. Nokia Corporation et al.*, Case No. 24-cv-4269 (LMB/DTS) (D. Minn. Nov. 25, 2024)	

I. INTRODUCTION

The Director should reject Nokia Technologies Oy's ("Patent Owner" or "Nokia") request for discretionary denial (Paper No. 7, "DD-Brief") and institute trial in this proceeding.

The facts and equities here closely parallel recent decisions by the Deputy Director, who has consistently declined to exercise discretion to deny institution where, as here, the balance of factors weighs in favor of Board review of U.S. Patent No. 7,724,818 (the "'818 Patent," EX-1001). In particular, the Deputy Director's decisions in *Mercedes-Benz Group AG v. The Phelan Group, LLC* (IPR2025-00413 and IPR2025-00919 et al.), *Tesla, Inc. v. Intellectual Ventures II LLC* (IPR2025-00217 et al.), and *ARM Ltd. v. Daedalus Prime LLC* (IPR2025-00207) provide clear guidance that supports institution in this proceeding.

First, there is **No Parallel Litigation or Advanced District Court Proceedings**: In *Mercedes-Benz v. Phelan*, the Deputy Director found that the absence of a scheduled trial date and minimal investment in the district court proceeding weighed against discretionary denial. *Mercedes-Benz*, IPR2025-00413, Paper No. 13 (PTAB June 25, 2025). Here, as in that case, there is no parallel proceeding against Petitioner Snap Inc. ("Petitioner" or "Snap") involving the '818 Patent, so the concerns in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper No. 11 (PTAB Mar. 20, 2020), do not apply and there is no risk of duplicative proceedings

or wasted resources. Indeed, Snap brought this challenge as soon as possible ***before*** any litigation against Snap. The parties voluntarily entered into an agreement that imposed contractual obligations on both parties, including a limitation against filing IPRs relating to patents of the other party, between May 15, 2023, and May 15, 2025. Snap filed the Petition just over two months later. Notably, Snap was unaware of the '818 Patent prior to Nokia's first contact in April 2023. This factor strongly favors institution.

Second, instituting trial in this proceeding would also be an **Efficient Use of Board Resources Given Prior Board Findings**: In *ARM Ltd. v. Daedalus Prime*, the Deputy Director vacated a prior discretionary denial and referred the petition to the Board after related litigation was dismissed, noting that the Board had already found "substantially identical claims" unpatentable in a related patent. *ARM Ltd.*, IPR2025-00207, Paper No. 14 (PTAB Aug. 6, 2025). Similarly, here, the Board has already instituted IPR on the ***same grounds*** in a prior proceeding (*Amazon.com, Inc. v. Nokia Technologies Oy*, IPR2024-00572 (PTAB Apr. 1, 2024) (hereinafter the "Amazon IPR" or "Amazon Petition")), finding a reasonable likelihood of unpatentability. The prior proceeding was terminated before a final written decision due to a settlement between the parties, so the Board's work in evaluating the claims and prior art can be efficiently leveraged in this proceeding, just as the Deputy Director found appropriate in *ARM Ltd*. Indeed,

the facts are even stronger here than in *ARM Ltd.*, because here the Board did not consider "substantially identical claims," but the very same claims.

Third, there are **No Settled Expectations of Validity**: In both *Mercedes-Benz* and *Tesla*, the Deputy Director rejected arguments that the patent owner's "settled expectations" of validity should weigh in favor of discretionary denial, especially where the patent had already been subject to significant validity challenges. Here, Nokia's assertion of settled expectations is even weaker: The '818 Patent was already subject to an instituted IPR where the Board instituted on the same grounds, finding a "reasonable likelihood that [Petitioner] would prevail with respect to at least one of the challenged claims." *Amazon.com*, IPR2024-00572, Paper No. 11 at 2 (EX-1029). This preliminary determination was never disturbed, as the prior proceeding terminated shortly after institution due to a settlement between the parties. *See id*., Paper No. 26 (Apr. 1, 2025), 29 (Apr. 3, 2025). And Nokia has a history of asserting and settling matters before a final validity determination. *See* App. A.

The public record supports only the expectation that the claims are likely unpatentable. Nokia's claims of prejudice or unfairness are unavailing. The Deputy Director repeatedly held that the mere passage of time or the existence of licensing activity does not create a settled expectation of validity, especially where the patent has been repeatedly challenged and no final decision has issued.

Mercedes-Benz, IPR2020-00413, Paper No. 13 (PTAB June 25, 2025); *Tesla*, IPR2025-00217, Paper No. 9 (PTAB June 13, 2025); *see also, e.g.*, *Datadome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper No. 13 (PTAB Aug. 14, 2025) at 2–3.

Fourth, instituting trial will also serve **Judicial Economy and Congressional Intent**: The Deputy Director in *Tesla v. Intellectual Ventures* recognized that the Board is well-suited to address complex patent validity issues, especially where multiple patents and diverse subject matter are involved. *Tesla*, IPR2025-00217. Here, the Board's expertise and prior familiarity with the '818 Patent and the asserted prior art make this forum the most efficient and reliable venue for resolving the validity question, consistent with congressional intent to provide a "quick, inexpensive, and reliable alternative to district court litigation." S. Rep. No. 110-259 at 20 (2008).

Fifth, there are **No Relitigation or Serial Petition Concerns**: Nokia's argument that Snap's Petition "relitigates" the same grounds as the ITC and Amazon IPR is misplaced. DD-Brief at 2. The Deputy Director has made clear that discretionary denial is not warranted where no final adjudication has occurred and where the Board previously found a reasonable likelihood of unpatentability. *Tesla*, IPR2025-00217, Paper No. 9. Here, the prior IPR was instituted but terminated by settlement, and the ALJ's determination is not final. There is no risk

of wasteful re-litigation or abuse of process.

The Deputy Director's recent decisions establish a clear pattern: Where, as here, there is no parallel litigation involving the petitioner, the Board has already found a reasonable likelihood of unpatentability, and the petition is timely and well-supported, discretionary denial is not appropriate. Applying this well-established precedent here, Nokia's request for discretionary denial should be rejected, and trial should be instituted. This approach best serves the interests of efficiency, fairness, and the public's right to challenge questionable patents.

Snap is using the IPR process here in precisely the way Congress intended—as a less expensive alternative to courtroom litigation. *See* 157 Cong. Rec. S1352 (Mar. 8, 2011) (statement of Sen. Mark Udall) ("Inter partes . . . proceedings are intended to serve as a less-expensive alternative to courtroom litigation and provide additional access to the expertise of the Patent Office on questions of patentability."); S. Rep. No. 110-259 at 20 (2008) (stating that the purpose of the IPR procedure is to provide "a quick, inexpensive, and reliable alternative to district court litigation to resolve questions of patent validity").

Moreover, Nokia's history of litigious behavior concerning the '818 Patent and others in its portfolio strongly suggests it is likely to sue not only Snap but others. Snap therefore sought access to the Board's expertise in efficiently resolving the question of unpatentability, which is exactly what Congress wanted

companies like Snap—facing a patent of dubious validity—to do. *See* H.R. Rep. 112-98, at 69 (2011) (stating that IPRs "limit unnecessary and counterproductive litigation costs"); *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020) (stating that a purpose of IPRs is to "weed out bad patent claims efficiently"); *see also Pope Mfg. Co. v. Gormully*, 144 U.S. 224, 234 (1892) ("[C]ompetition should not be repressed by worthless patents."). The Board has an opportunity now to consider the unpatentability of a patent that has been and almost certainly will be asserted (and challenged) again. It would therefore be contrary to congressional intent and inefficient to deny Snap's Petition on discretionary grounds.

Sixth, under the Acting Director's recent Memorandum on "PTAB consideration of prior findings of fact and conclusions of law" dated September 16, 2025, the Board should presumptively follow "an ***initial*** or final decision on a finding of fact or conclusion of law" from a prior proceeding before the Board on the same patent, and any deviation requires "more detailed explanation" for why a different outcome is warranted (emphasis added). Nokia has not met its burden of justifying a different outcome from the initial findings in the Amazon IPR institution decision.

II. THE PETITION SHOULD NOT BE DENIED ON DISCRETIONARY GROUNDS.

A. Snap's Petition Does Not Relitigate the Merits.

Nokia misinterprets the discretionary consideration of "[w]hether the PTAB or another forum has already ***adjudicated*** the validity or patentability of the challenged patent claims." DD-Brief at 4, 7 (emphasis added). Nokia incorrectly contends that the mere prior ***assertion*** of an invalidity ground constitutes "adjudication," even if no final judgment or decision was handed down. *See id.* at 7–8. Nokia's argument is illogical because the only prior decision by the Board was to ***institute*** an IPR on the same grounds as Snap's Petition.[1] *Id.* Amazon and Nokia settled shortly thereafter. *See Amazon.com*, IPR2024-01176, Paper No. 13. Nokia nonetheless contorts these facts to argue that the present IPR should be discretionarily denied, citing two decisions where institution was denied. DD-Brief at 9–10. Both are inapposite. In *Webgroup Czech Republic*, the petition was

[1] While Nokia claims that Dr. Saber's declaration was "copied" from the Amazon IPR (DD-Brief at 3), in fact, neither the Petition nor Dr. Saber's declaration is identical to the versions in the Amazon IPR, and the present petition includes claims that were not previously addressed in the Amazon IPR. *Compare, e.g.*, EX-1003, ¶ 130 *with* EX-2004, ¶ 148.

discretionarily denied, in part, because one petition was ***already pending*** before a decision on discretionary denial was made. *Webgroup Czech Republic, A.S. v. Dish Techs. LLC*, IPR2025-00467, Paper No. 14 at 2 (PTAB Jan. 17, 2025). Here, there is no other petition pending, nor has any prior petition been decided on the merits. Nokia also cites *Murata Manufacturing Co.*[2] to argue that the instant petition should be denied as a "serial petition," but *Murata* did not involve serial petitions, let alone a patent for which the Board previously instituted IPR. As explained below, Snap's Petition is not a copycat[3] and contains further arguments and

[2] While Nokia stresses the point that the petitioner in *Murata* failed to seek early review of the patent leading to discretionary denial, the circumstances in that case are far different than the present case. In *Murata*, the IPR was filed in 2025 even though there were discussions between the parties dating back to 2007. *Murata Mfg. Co. v. Ga. Tech Rsch. Corp.*, IPR2025-00383, Paper No. 14 at 2 (PTAB Feb. 10, 2025). Here, the parties voluntarily entered into an agreement that imposed contractual obligations on both parties, including a limitation against filing IPRs relating to patents of the other party, between May 15, 2023, and May 15, 2025. There is no evidence of gamesmanship or delay by Snap.

[3] Even if this were a copycat petition, such petitions are entirely permissible, particularly in cases where the previous petition was instituted.

evidence showing that the ’818 Patent claims are unpatentable. Thus, the cases Snap cites above are more analogous to the facts at hand. *Mercedes-Benz*, IPR2025-00413, Paper No. 13 at 2 (holding that because “claims of a related patent were recently found unpatentable . . . [this] factor[] weigh[s] against discretionary denial”); *Mercedes-Benz*, IPR2025-00919, Paper No. 10 at 2 (PTAB Apr. 23, 2025) (“The challenged patent in IPR2025-00413 [which Petitioner demonstrated a reasonable likelihood of prevailing in showing unpatentability] has similar claims to those challenged in these proceedings and the IPR2025-00413 petition relies on prior art similar to the prior art raised in these Petitions.”); *ARM Ltd.*, IPR2025-00207, Paper No. 14 at 3 (instituting in part because “the Board already has determined that ‘substantially identical claims’ in a related patent to the challenged patent are unpatentable based on one of the prior art references asserted in this proceeding”); *Tesla*, IPR2025-00217, Paper No. 9 at 2 (noting that the “Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable in three separate proceedings with respect to some of the challenged patents in these proceedings,” which “counsel[s] against discretionary denial”).

Because there has been no final adjudication on the merits in any forum of the challenged claims and the Board previously found a reasonable likelihood that a petitioner asserting the same grounds was likely to prevail on the merits, this

factor weighs heavily against discretionary denial. Previous decisions by the Deputy Director made clear that discretionary denial is not warranted where the Board previously found a reasonable likelihood of unpatentability.

B. Snap's Challenge Is Likely to Invalidate the Claims of the '818 Patent Based on the Substance of the Petition.

Nokia's argument that the Petition lacks merit is contradicted by the ***previously instituted*** IPR, which challenged the '818 Patent on the same prior art grounds. As discussed above, the Deputy Director has held that when the Board has found a reasonable likelihood that similar claims of a related patent are unpatentable, this weighs against discretionary denial. *Tesla*, IPR2025-00217, Paper No. 9 at 2. The facts here are even stronger because the Board previously found a reasonable likelihood that the same claims of the same patent are unpatentable based on the same prior art.

In short, the Board has already considered the grounds of the present Petition and concluded they presented a reasonable likelihood of success in showing the challenged claims are unpatentable. Snap's Petition only makes the challenge stronger on the merits. Thus, there can be no doubt that the strength of the unpatentability challenge weighs heavily against discretionary denial.

Nokia argues that the Amazon IPR was instituted without the consideration of the ALJ's adjudication from the ITC investigation and thus argues that this IPR

petition lacks merit. DD-Brief at 9-12. This argument is misplaced. As Nokia's briefing admits, the ALJ only made an "***Initial*** Determination" rather than a final adjudication. DD-Brief at 10 (emphasis added). Moreover, the ALJ applies the clear and convincing evidentiary standard when addressing validity, which is a higher burden of proof than the Board applies. *Nobel Biocare Servs. AG v. Instradent USA, Inc*., 903 F.3d 1365, 1375 (Fed. Cir. 2018).[4] And as Nokia also admits, any priority date issues require "extensive fact and expert discovery . . .

[4] The Federal Circuit in *Nobel* rejected the argument that Nokia makes here. In *Nobel*, the ITC determined that a reference was not shown to qualify as prior art. The Federal Circuit affirmed the ITC's finding. In a subsequent IPR, the Board found the reference did qualify as prior art. In *Nobel*, the Federal Circuit affirmed the Board and rejected the argument that the ITC's prior holding was controlling, explaining that "[a]s the Board correctly observed, the evidentiary standard in its proceedings, preponderance of the evidence, is different from the higher standard applicable in ITC proceedings, clear and convincing evidence. . . . [O]ur prior affirmance of the ITC's judgment on a different factual record with a different burden of proof does not dictate the outcome of this appeal." 903 F.3d at 1375. Further, here, there was no final determination from the ITC and no affirmance thereof by the Federal Circuit.

and a trial on the priority date issue," which requires more than the mere attorney argument found in Nokia's brief. DD-Brief at 11. Because there was no final adjudication on the merits in any venue, the ALJ's initial finding in the ITC matter was under a more stringent burden of proof, and the Board previously instituted on the same grounds, this factor weighs in favor of institution.

C. Petitioner's Reliance on Expert Testimony Is Reasonable.

Nokia argues that Snap "over-relies" on the declaration of Dr. Saber to fill gaps in the prior art. Nokia's position essentially comes down to the fact that Snap's Petition cites Dr. Saber's "133-page" declaration "over 300 times." DD-Brief at 13. This does not warrant discretionary denial, and the Board has rejected substantially the same argument. *See, e.g.*, *Razdog Holdings LLC v. Twitch Interactive, Inc.*, IPR2025-00307, Paper No. 11 at 18–19 (Mar. 28, 2025) (patent owner's request for discretionary denial); *id.*, Paper No. 18 at 3 (PTAB May 16, 2025) (denying request for discretionary denial despite the petition "cit[ing] its expert's 269-page declaration at least 260 times"). That an expert would be frequently cited throughout the petition is not surprising, as the petition must be supported with evidence and not mere attorney argument. Indeed, in its Patent Owner Preliminary Response to the Amazon Petition, Nokia referenced a 72-page declaration of its own expert, Dr. Omid Kia, 60 times.

Further, Nokia offers only one example wherein it contends Dr. Saber "fill[s]

in [a] gap" in the art. Even in that isolated case, Nokia's argument appears to be that it disagrees with the rationale regarding the technical motivation to combine references as opposed to providing any evidence that he actually filled in a gap in the prior art. DD-Brief at 14. Moreover, despite there being a declaration from its own expert in the Amazon IPR, Nokia cites no expert testimony of its own to argue that Dr. Saber's assertions are incorrect, but instead makes attorney arguments that lack merit and should be rejected. *See id*. Nokia's conclusory argument cannot justify discretionary denial, as the Deputy Director has made clear. *See, e.g.*, *Cambridge Indus. USA Inc. v. CIT Northbridge Credit LLC*, IPR2025-00433 (PTAB Jan. 17, 2025), Paper No. 11 at 2 ("Patent Owner does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.").

Further, Nokia under-cuts its own argument that Dr. Saber fills in gaps by arguing that Dr. Saber provides "only a cursory analysis of the prior art using language that tracks the Petition" and is "essentially no different in scope and content than the Petition." DD-Brief at 12-13.

In summary, Snap's reliance on Dr. Saber is largely consistent with the approach taken by Amazon in its previously instituted petition. The citations to Dr. Saber were appropriate and necessary, given the nature of the technology discussed. Thus, this factor weighs against discretionary denial.

D. Nokia Had No Reasonable Settled Expectation of Validity.

Nokia argues that the "'818 Patent issued on May 25, 2010" and has "been in force for over fifteen years, creating strong settled expectations." DD-Brief at 4 (internal citations omitted). Nokia's "settled expectation" argument is misplaced, given that the patent was subject to an instituted IPR as discussed above. Indeed, the only expectation grounded in the public record is that the challenged claims are ***un***patentable. None of the decisions Nokia cites for its settled expectations argument involves a situation in which the patent in question was the subject of an IPR previously instituted on the merits. Indeed, as discussed prior, discretionary denial is not warranted where no final adjudication has occurred and where the Board previously found a reasonable likelihood of unpatentability. *Tesla*, IPR2025-00217, Paper No. 9.

While Nokia argues that because "[n]o court, agency, or the PTAB has ever found any claim of the '818 Patent invalid . . . the Parties have settled expectations" (DD-Brief at 6), Nokia ignores the fact that the validity of the '818 Patent has been repeatedly challenged at the PTAB and ITC, as discussed *supra*. Further, the parties voluntarily entered into an agreement that imposed contractual obligations on both parties, including a limitation against filing IPRs relating to patents of the other party, between May 15, 2023 and May 15, 2025. Snap filed this Petition two months later. Regardless, Snap had a reasonable expectation that the

patent was invalid as soon as it became aware of Amazon's validity challenge. *See Amazon.com*, IPR2024-01176, Paper No. 3. Thus, this factor weighs against discretionary denial.

E. Other Considerations Bearing on the Director's Discretion.

Nokia admits it is a serial litigant. Nokia touts that "Patent Owner has a well-established patent licensing program relating to the video coding technology space and has over 50 license agreements that encompass the '818 Patent." DD-Brief at 6. The '818 Patent has been the subject of litigation since 2019. *See, e.g.*, *Element Television Co. v. Nokia Corp.*, No. 0:24-cv-04269 (D. Minn. Nov. 25, 2024);[5] *Nokia Techs. Oy v. Amazon.com, Inc.*, No. 1:23-cv-01236 (D. Del. Oct. 31, 2023) ; *see also* App. A.

Moreover, the Board is in a strong position to efficiently determine unpatentability based on Snap's Petition because it instituted the Amazon Petition on the same grounds. Thus, the Board will not have to get up to speed on the relevant arguments. Administrative economy weighs in favor of picking up where the Board left off and addressing the merits of Snap's Petition.

[5] While there was a declaratory judgment action filed by Element against the '818 Patent (*see* EX-2009), the parties reached a resolution in that matter (*see* EX-1028) (Notice of Dismissal).

F. The New Interim Process Should Not Govern the Decision to Institute.

Petitioner also respectfully submits that the standards articulated in the June 2022 Procedures should apply to this Petition, until the Board issues new regulations in accordance with 35 U.S.C. § 316 and the Administrative Procedure Act ("APA").

The Office announced significant changes to applicable standards beginning March 2025, e.g., with the March 24, 2025 Memorandum of Chief Administrative Patent Judge Scott Boalick (the "Boalick Memo") and the March 26, 2025 Memorandum of Acting Director Stewart (the "Acting Director Memo"). The Acting Director Memo introduced an entirely new "interim process" that bifurcates institution between "(i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations." Acting Director Memo at 1 (EX-1025). Under this new procedure, "the Director, in consultation with at least three PTAB judges," will determine whether discretionary denial is appropriate based on "all relevant considerations," including several newly enumerated factors. *Id*. Three weeks after the Acting Director Memo was issued, the USPTO held an oral webcast setting forth additional substantive details of the new interim procedure not found in the Acting Director Memo. Then, eight days after the webcast, the USPTO posted on its website "FAQs for Interim Processes for PTAB Workload

Management" (EX-1026) with more substantive details, some potentially in conflict with details provided during the oral webcast. Since then, the webpage has been archived and replaced with an "Interim Director Discretionary Process" webpage including additional information on the discretionary considerations process. *See* EX-1027.

Then, on October 17, 2025, the Director issued a new Memorandum titled "Director Institution of AIA Trial Proceedings," in which the Director announced that he would take over determining whether to institute trial in IPR proceedings. EX-1030 ("Director Institution Memo"). But the Director confirmed that this new approach to institution "flows from the processes outlined in the March 26, 2025 memorandum . . . under which the Director determines whether or not to deny a petition based on discretionary considerations." *Id*.

Petitioner respectfully submits that these new procedures—as announced in the Boalick Memo, the Acting Director Memo, the oral webcast, the FAQs, and the Director Institution Memo (collectively, the "Announcements")—fall short of satisfying the requisite statutory and due-process obligations of the Office.

By way of example, 35 U.S.C. § 316(a) mandates that "[t]he Director shall prescribe regulations," including regulations "setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a)." The Announcements fall short of 35 U.S.C. § 316(a) by:

1. Making changes without going through notice-and-comment rulemaking, particularly given the agency's representation that it will make any further changes to the institution process through notice-and-comment rulemaking. *See* 88 Fed. Reg. 24,503 (Apr. 21, 2023). The Announcements violate the notice-and-comment requirements under the APA and are arbitrary and capricious.

2. Proposing considerations that lack clarity so that they fail to set "forth the standards for the showing of sufficient grounds to institute review." 35 U.S.C. § 316(a). For example, many of the new "considerations" set forth in the Director Memo have no basis in Federal Circuit law or Office regulations such that petitioners cannot anticipate how the Director will apply them.

3. Lacking a sufficiently reasoned explanation for the changes in the factors relevant to institution, including changes that directly contradict the agency's prior guidance in the June 2022 Procedures—such as the controlling effect of a *Sotera* stipulation and the relevance of compelling merits. The passing reference to "efficiency" in the Announcements does not explain how the changes will aid that goal.[6] *See Food & Drug Admin. v. Wages & White Lion Invs., L.L.C.*,

[6] A self-imposed reduction in office staff and judges to reduce the Board's ability to perform its statutory functions should not be viewed as a rational basis to use discretionary denial to frustrate Congress's intent.

145 S. Ct. 898, 906 (2025) (explaining that when an agency changes position, it must "offer 'good reasons for the new policy'"); *see also F.C.C. v. Fox Television Stations, Inc.*, 556 U.S. 502, 515 (2009) (holding that an agency changing position must show "that the new policy is permissible under the statute, that there are good reasons for it, and that the agency believes it to be better, which the conscious change of course adequately indicates").

4. Creating at least a perception of a lack of transparency in the discretionary stage of the new bifurcated process. For example, a FAQs webpage that may be "frequently" updated "controls the interim processes." EX-1026 at 1 (encouraging stakeholders to "check back frequently for updates"). Further, there is no way for the parties to know who is designated to advise the Director and, thus, whether there are any conflicts of interest or other procedural concerns related to the process.

5. Creating new extra-statutory institution criteria—the age of the challenged patent and the concept of "settled expectations"—that finds no support in the IPR statute (35 U.S.C. § 311 *et seq*.) or in the congressional record. The USPTO, as an administrative agency, "possess[es] only the authority that Congress has provided." *Nat'l Fed'n of Indep. Bus. v. Dep't of Lab., Occupational Safety & Health Admin*., 595 U.S. 109, 117 (2022). The America Invents Act did not authorize the Director to create new institution criteria that find no basis in the

statute. These new institution criteria exceed the PTO's statutory authority and qualify as actions that should be struck down under 5 U.S.C. § 706(2).

6. Holding that as of October 20, 2025, the Director will issue only a "summary notice" to the parties either denying or granting institution. Thus, petitioners will not know whether their petitions were denied due to the merits, discretionary considerations, or "other non-discretionary considerations." Director Institution Memo at 2. This too creates a lack of transparency without good cause, violates the notice-and-comment requirements under the APA, is arbitrary and capricious, and contravenes 35 U.S.C. § 316(a).

In the face of this nonexclusive list of deficiencies, Petitioner respectfully requests that (1) the Director consider whether to institute based on the standards articulated in the June 2022 Procedures until such time as the Board issues new regulations in accordance with 35 U.S.C. § 316 and the rulemaking procedures of the APA; and (2) refrain from crediting Nokia with "settled expectations" based on the age of the '818 Patent.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that a trial be instituted in this proceeding.

Dated: November 5, 2025

Respectfully submitted,

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CERTIFICATION OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24 and the Interim Process for PTAB Workload Management, the undersigned hereby certifies that the word count for the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL totals 20 pages. Accordingly, this Opposition is under the page limit of 20 pages.

Dated: November 5, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.205(b), I hereby certify that on November 5, 2025, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by email on the following:

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APPENDIX A

Case	Patents Asserted	Status
ASUSTeK Computer, Inc. v. Nokia Technologies Oy, IPR2025-01153 (PTAB June 16, 2025)	10,536,714	Pending
ASUSTeK Computer, Inc. v. Nokia Technologies Oy, IPR2025-01279 (PTAB July 16, 2025)	8,050,321	Pending
Certain Video-Capable Laptop, Desktop Computers, Handheld Computers, Tablets, Televisions, Projectors, and Components and Modules Thereof, Inv. No. 337-TA-1448 (ITC Apr. 11, 2025)	8,050,321 9,036,701 10,536,714 11,805,267	Pending
Nokia of America Corporation v. Acer Inc., 1-25-cv-01106 (D. Del. Sept. 3, 2025)	7,797,615 8,737,333 8,787,304 8,798,663 9,807,746 9,999,097 10,237,791 11,044,053 11,252,641	Pending
Nokia Technologies Oy v. Paramount Skydance Corporation et al., 1-25-cv-01054 (D. Del. Aug. 23, 2025)	6,711,211 6,856,701 6,950,469 6,968,005 7,082,450 7,289,674 7,532,808 8,005,145	Pending

	8,050,321 8,107,744 8,175,148 8,776,204 9,800,891	
Snap, Inc. et al. v. Nokia Technologies Oy, IPR2025-01263 (PTAB July 23, 2025)	10,536,714	Pending
Snap, Inc. v. Nokia Technologies Oy, IPR2025-01338 (PTAB July 23, 2025)	**7,724,818**	Pending
Snap, Inc. et al. v. Nokia Technologies Oy, IPR2025-01345 (PTAB Aug. 21, 2025)	9,036,701	Pending
Snap, Inc. et al. v. Nokia Technologies Oy, IPR2025-01439 (PTAB Sept. 2, 2025) *Snap, Inc. et al. v. Nokia Technologies Oy*, IPR2025-01440 (PTAB Sept. 2, 2025)	7,532,808	Pending
Nokia Technologies Oy v. Acer Inc. et al., 1-25-cv-00523 (W.D. Tex. Apr. 7, 2025)	7,532,808 8,050,321 9,036,701 10,536,714 11,805,267	Stayed pending ITC 337-TA-1448
Nokia Technologies Oy v. ASUSTeK Computer Inc. et al., 2-25-cv-03053 (C.D. Ca. Apr. 7, 2025)	7,532,808 8,050,321 9,036,701 10,536,714 11,805,267	Stayed pending ITC 337-TA-1448
Nokia Technologies Oy v. Hisense Co. Ltd. et al., 1-25-cv-01871 (N.D. Ga. Apr. 7, 2025)	7,532,808 8,050,321	Stayed pending ITC 337-TA-1448

	9,036,701 10,536,714 11,805,267	
Amazon.com, Inc. et al v. Nokia Technologies Oy, IPR2024-00572 (PTAB Apr. 1, 2024)	**7,724,818**	Settled
Amazon.com, Inc. et al v. Nokia Technologies Oy, IPR2024-00847 (PTAB May 10, 2024)	7,532,808	Settled
Amazon.com, Inc. et al v. Nokia Technologies Oy, IPR2024-00848 (PTAB May 10, 2024)	7,532,808	Settled
Amazon.com, Inc. et al v. Nokia Technologies Oy, IPR2024-01176 (PTAB Aug. 30, 2024)	8,175,148	Settled
Certain Electronic Devices, Including Computers, Tablet Computers, and Components and Modules Thereof, Inv. No. 337-TA-1208 (ITC July 1, 2020)	6,950,469 7,532,808 **7,724,818** 8,144,764 8,583,706	Settled
Element Television Company, LLC et al v. Nokia Corporation et al., 24-cv-04269 (D. Mn. Nov. 25, 2024)	6,856,701 6,950,469 6,968,005 7,263,125 7,280,599 7,532,808 **7,724,818** 8,036,273 8,050,321 8,077,991 8,144,764 8,175,148	Settled

	8,204,134 9,571,833 9,800,891 10,536,714 11,805,267	
Element TV Company, LP et al v. Nokia Corporation et al., IPR2025-01108 (PTAB June 13, 2025)	7,532,808	Settled
Element TV Company, LP et al v. Nokia Corporation et al., IPR2025-01109 (PTAB June 13, 2025)	7,532,808	Settled
Element TV Company, LP et al v. Nokia Technologies Oy et al., IPR2025-01068 (PTAB June 4, 2025)	8,050,321	Settled
Nokia Corporation et al v. Amazon.com, Inc., 1-23-cv-01232 (D. Del. Oct. 27, 2023)	7,480,254 7,532,808 **7,724,818** 8,050,321 8,077,991 8,204,134 8,918,741 8,996,693 9,473,602 10,536,714 11,805,267	Settled
Nokia Technologies Oy et al v. Apple Inc., 2-16-cv-01440 (E.D. Tex. Dec. 21, 2016)	6,680,974 6,711,211 6,856,701 6,950,469 6,968,005 7,532,808	Settled

	7,548,584 7,551,546 8,036,273 8,090,026 8,144,764 8,630,33,9 8,737,484 8,976,734 9,106,288	
Nokia Technologies Oy v. Amazon.com, Inc. et al., 1-23-cv-01236 (D. Del. Oct. 31, 2023)	6,856,701 6,950,469 6,968,005 7,532,808 **7,724,818** 8,036,273 8,050,321 8,077,991 8,144,764 8,175,148 9,390,137 9,571,833 9,800,891 11,805,267	Settled
Nokia Technologies Oy v. HP Inc., 1-23-cv-01237 (D. Del. Oct. 31, 2023)	6,950,469 7,280,599 7,532,808 **7,724,818** 8,036,273	Settled

	8,050,321 8,077,991 8,204,134 10,536,714 11,805,267	
Nokia Technologies Oy v. Lenovo Group Ltd., et al., 5-19-cv-00427 (E.D. N.C. Sept. 25, 2019)	6,856,701 6,950,469 6,968,005 7,263,125 7,280,599 7,532,808 **7,724,818** 8,036,273 8,144,764 8,583,706 9,800,891	Settled
Video Capable Electronic Devices, Including Computers, Streaming Devices, Televisions, Cameras, and Components and Modules Thereof, Inv. No. 337-TA-1379 (ITC Oct. 31, 2023)	7,532,808 8,204,134	Settled